



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,442	10/31/2001	Mike Sheldon	MFCP.81059	2397
45809 7590 02/24/2010 SHOOK, HARDY & BACON L.L.P. (MICROSOFT CORPORATION) INTELLECTUAL PROPERTY DEPARTMENT 2555 GRAND BOULEVARD KANSAS CITY, MO 64108-2613				
EXAMINER				
HUYNH, BA				
ART UNIT		PAPER NUMBER		
2179				
MAIL DATE		DELIVERY MODE		
02/24/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MIKE SHELDON, RICHARD STOAKLEY, and
JAMES F. SPRINGFIELD

Appeal 2009-004442
Application 10/001,442¹
Technology Center 2100

Decided: February 24, 2010

Before JEAN R. HOMERE, STEPHEN C. SIU, and DEBRA K.
STEPHENS, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Filed on October 31, 2001. The real party in interest is Microsoft Corp.
(App. Br. 3.)

I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) (2002) from the Examiner's final rejection of claims 1, 3 through 9, and 11 through 14. (App. Br. 2.)² Claims 2, 10, 15, and 16 have been cancelled. (*Id.*) We have jurisdiction under 35 U.S.C. § 6(b) (2008).

We affirm.

Appellants' Invention

Appellants invented a method, system, and computer-readable medium for automatically rendering a window on a computer display screen in a maximized state when a certain resolution threshold is met. (Spec. 1, ll. 7-9; Spec. 4, ll. 19-21.) According to Appellants, the invention considers the screen resolution in order to display information that is readable and pleasing to the eye. (Spec. 4, ll. 11-16.)

Illustrative Claim

Independent claim 1 further illustrates the invention as follows:

1. A method in a computer system for displaying a graphical window on a display screen having a screen resolution, comprising:
 - determining, for the window, whether a display size and display screen position are specified for the window;
 - if a size and position are specified, rendering the window at the specified size and in the specified position so that the window is not automatically maximized;
 - if the size and position are not specified, determining the screen resolution for the display screen;
 - comparing the screen resolution against a pre-determined threshold value; and
 - automatically maximizing the size of the window on the display screen if the screen resolution is below the pre-

² See the Amended Appeal Brief filed May 12, 2008, which only includes a revised status of claims on appeal.

determined threshold value, wherein the screen resolution does not change.

Prior Art Relied Upon

The Examiner relies on the following prior art as evidence of unpatentability:

Rodden	6,473,102 B1	Oct. 29, 2002 (filed May 11, 1999)
Buote	6,581,020 B1	Jun. 17, 2003 (filed Oct. 10, 2000)
Hatori	2002/0075289 A1	Jun. 20, 2002 (filed Jun. 1, 2001)

Rejection on Appeal

The Examiner rejects the claims on appeal as follows:

Claims 1, 3 through 9, and 11 through 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Rodden and Buote.

Appellants' Contentions

Appellants contend that Rodden's disclosure of calculating a preferred size and position for a window teaches away from Buote's disclosure that all windows are the same size without regard to screen resolution. (App. Br. 12-13.)³ Further, Appellants argue that the proffered combination teaches away from the claimed maximization of windows whereby the size and position are not specified and the screen resolution is below a predetermined resolution threshold. (*Id.* at 13-14.) Additionally, Appellants allege that Rodden and Buote are not within the scope of the prior art analogous to the

³ Hereafter, we refer to the Appeal Brief filed on April 29, 2008.

claimed invention and, therefore, do not teach the claimed window maximization method. (*Id.* at 15-16.)

Appellants contend that Rodden's disclosure of a user designating a window in a "keep visible" state, in conjunction with Buote's disclosure of always rendering windows in a maximized state, does not teach determining a size and screen position for a specified window and rendering accordingly. (*Id.* at 16-17.) Further, Appellants argue that Rodden's disclosure of resizing a window once a change in resolution occurs and moving the window outside a display area does not teach rendering a window in a non-maximized state at a specified size and position. (Reply Br. 9-10.) Additionally, Appellants allege that Buote's disclosure of uniform maximization does not teach the claimed ability to maximize the size of a window based on comparing the screen resolution against a predetermined threshold. (App. Br. 17.) In particular, Appellants contend that Buote's disclosure of a maximized mode and window mode does not teach a threshold for display resolution, as claimed. (Reply Br. 11-12.) Finally, Appellants allege that Rodden's disclosure of effectively changing the screen resolution by switching from a LCD monitor to a notebook monitor, in conjunction with Buote's disclosure of changing screen resolution, does not teach "wherein the screen resolution does not change," as recited in independent claim 1. (App. Br. 18; Reply Br. 11.)

Examiner's Findings and Conclusions

The Examiner finds that Rodden's disclosure of resizing and repositioning windows does not teach away from Buote's disclosure of displaying a window in maximized mode or window mode based on a screen resolution. (Ans. 11-12.) Further, the Examiner finds that Rodden's

disclosure of maintaining the size and position of specified windows, in conjunction with Appellants' admission that Buote's windows alter their size when a resolution threshold is crossed, teaches the claimed invention. (*Id.* at 12.) Additionally, the Examiner finds that both Rodden and Buote are reasonably pertinent to the particular problem with which Appellants were concerned at the time of the claimed invention because both references are directed to the problem of responding to resolution change in a graphical user interface ("GUI") display. (*Id.* at 14.)

The Examiner finds that Rodden's disclosure of allowing a user to identify which windows the user would like to keep visible on the desktop amounts to determining a size and screen position for a specified window and rendering accordingly. (*Id.* at 15-16.) Further, the Examiner finds that Buote's disclosure of utilizing a 600x800 screen resolution threshold when determining whether to display a window in a maximized mode or a window mode teaches comparing a screen with a resolution threshold, as claimed. (*Id.* at 16.) Additionally, the Examiner finds that Rodden's disclosure of changing from a first display device to a second display device, whereby the resolution remains the same, teaches "wherein the screen resolution does not change," as recited in independent claim 1. (*Id.* at 17.)

II. ISSUE

Have Appellants shown that the Examiner erred in concluding that the combination of Rodden and Buote renders independent claim 1 unpatentable? In particular, the issue turns on whether:

(a) the proffered combination teaches “determining, for the window, whether a display size and display screen position are specified for the window,” as recited in independent claim 1;

(b) the proffered combination teaches “if a size and position are specified, rendering the window at the specified size and in the specified position so that the window is not automatically maximized,” as recited in independent claim 1;

(c) the proffered combination teaches “comparing the screen resolution against a pre-determined threshold value,” as recited in independent claim 1;

(d) the proffered combination teaches “automatically maximizing the size of the window on the display screen if the screen resolution is below the pre-determined threshold value, wherein the screen resolution does not change,” as recited in independent claim 1;

(e) Rodden and Buote are both reasonably pertinent to the particular problem with which Appellants were concerned at the time of the claimed invention; and

(f) the combination of Rodden and Buote is impermissible because Rodden’s disclosure of calculating a preferred size and position for a window teaches away from Buote’s disclosure of displaying all window screens in 600x800 resolution.

III. FINDINGS OF FACT

The following Findings of Fact (“FF”) are shown by a preponderance of the evidence.

Appellants' Specification

1. Appellants' Specification states that "[s]ome windows are not equipped to be maximized, but are only created to be one size." (Spec. 12, ll. 14-15.) Further, Appellants' Specification states "[t]hese windows are incapable of maximization." (*Id.* at ll. 16-17.)

Rodden

2. Rodden generally relates to GUIs for computers and, in particular, "to the automatic repositioning and/or resizing of utility windows in response to actions that may affect the view or content of such windows on a display." (Col. 1, ll. 10-15.)

3. Rodden discloses that if a window is incapable of being fully displayed within the available display area, it is constrained to fit the current display area. (*Id.* at ll. 59-61.) Further, Rodden discloses that a user might be provided with a preference feature for each window, to allow certain types of windows to be identified as those which the user desired to keep visible on the desktop. (Col. 4, ll. 38-41.) Additionally, Rodden discloses that if a user expects to have a window at a particular position, it will remain at the position regardless of changes in the size or resolution of the display device. (Col. 2, ll. 15-17.)

4. Rodden discloses that a "user may be able to add or delete display devices, switch from one display device to another, or vary the resolution of the current display device." (Col. 3, ll. 54-56.) "By varying the resolution, the user is effectively provided with the ability to zoom in or zoom out, and thereby change the amount of information that is displayed." (*Id.* at ll. 57-59.)

5. Rodden discloses “automatically repositioning and/or resizing a window whenever an event occurs which could have an effect upon the content of the displayed window.” (Col. 4, ll. 13-17.)

Buote

6. Buote’s Figure 4 depicts a basic user interface design whereby all screens are 600x800 resolution. (Col. 11, ll. 1-2, 15.) “The display mode for each window depends on the screen resolution set for the computer. If the screen resolution is set at 600x800, all windows will appear in maximized mode. If the display mode is set higher than 600x800, then all windows will appear in window mode.” (*Id.* at ll. 15-20.)

7. Additionally, Buote’s Figure 4 depicts “upper right Windows-type buttons.” (*Id.* at ll. 23-24.) The X button (149) “will perform the same function as the ‘back:’ selection on any screen.” (*Id.* at ll. 24-25.)

Hatori

8. Hatori’s Figure 3 depicts an example of restoring a display window from a zoom display to its’ normal display. (Para. [0078].)

IV. PRINCIPLES OF LAW

Obviousness

“On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.” *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998) (citation omitted).

Section 103 forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at

the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007).

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” and discussed circumstances in which a patent might be determined to be obvious. *Id.* at 415 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966)). The Court reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 416. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.* at 417.

Analogous Art

“Whether a reference in the prior art is ‘analogous’ is a fact question.”

In re Clay, 966 F.2d 656, 658 (Fed. Cir. 1992) (citing *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568 n.9 (Fed. Cir. 1987)).

Two criteria have evolved for answering the question: “(1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor’s endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.”

Id. at 658-59 (citing *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986); *In re Wood*, 599 F.2d 1032, 1036 (CCPA 1979)).

Teaching Away

“What the prior art teaches and whether it teaches toward or away from the claimed invention ... is a determination of fact.” *Para-Ordnance Mfg., Inc. v. SGS Imps. Int'l, Inc.*, 73 F.3d 1085, 1088 (Fed. Cir. 1995) (citations omitted). “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). Teaching an alternative or equivalent method, however, does not teach away from the use of a claimed method. *In re Dunn*, 349 F.2d 433, 438 (CCPA 1965).

Official Notice

The Examiner may take notice of facts or common knowledge in the art which are capable of such instant and unquestionable demonstration as to defy dispute. *In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970). To challenge the Examiner's notice, Appellants must present evidence to the contrary. *In re Knapp-Monarch Co.*, 296 F.2d 230, 232 (CCPA 1961) (considering challenge to taking of judicial notice by Trademark Trial and Appeal Board).

V. ANALYSIS

Claim 1

Independent claim 1 recites, in relevant parts:

1) determining, for the window, whether a display size and display screen position are specified for the window; 2) if a size and position are specified, rendering the window at the specified size and in the specified position so that the window is not automatically maximized;

3) comparing the screen resolution against a pre-determined threshold value; and 4) automatically maximizing the size of the window on the display screen if the screen resolution is below the pre-determined threshold value, wherein the screen resolution does not change.

As detailed in the Findings of Fact section, Rodden discloses automatically repositioning or resizing windows within a GUI in response to changes in display configuration. (FF 2.) In particular, Rodden discloses providing a user with a preference feature for each window, thereby allowing the user to identify windows which will remain visible on the GUI. (FF 3.) Further, Rodden discloses that if a window is not capable of being fully displayed within the available display area of the GUI, it is rendered according to user-defined constraints regardless of the window size or resolution. (*Id.*) We find that Rodden's disclosure of user preferences teaches that a user may reposition or resize windows in a GUI display utilizing user-defined constraints. In particular, we find an ordinarily skilled artisan would readily appreciate that repositioning or resizing a window within a GUI display utilizing user-defined constraints amounts to determining the size and screen position of the window within a GUI display. We also find that Rodden's disclosure of rendering a window according to the user-defined constraints does not preclude displaying the window within the GUI display, whereby the window is not rendered in a maximized state.

In summary, we find that Rodden's disclosure teaches that a user may determine the size and screen position of a window within a GUI display to render the window accordingly. Thus, we find that Rodden's disclosure teaches "determining, for the window, whether a display size and display screen position are specified for the window," and, further, "if a size and

position are specified, rendering the window at the specified size and in the specified position so that the window is not automatically maximized,” as recited in independent claim 1.

Further, Rodden discloses automatically repositioning or resizing a window within a GUI display whenever an event occurs which effects the content therein. (FF 5.) Additionally, Buote discloses that the display mode for each window depends on the screen resolution set for the corresponding computer. (FF 6.) If the screen resolution is set at 600x800, all windows will appear in maximized mode. (*Id.*) If the screen resolution is set higher than 600x800, all windows will appear in window mode. (*Id.*) We find that Rodden’s disclosure teaches repositioning and resizing a window within a GUI display. We also find that Buote’s disclosure teaches comparing the screen resolution of each window against a predetermined screen resolution threshold (e.g., 600x800), whereby windows that are set at the threshold are rendered in a maximized state. Additionally, we find that Buote’s disclosure teaches that the resolution of the window does not change after the window is rendered in a maximized state. In summary, we find that Rodden’s disclosure of repositioning or resizing a window within a GUI display, in conjunction with Buote’s disclosure of maximizing a window based on a comparison to a predetermined screen resolution threshold, teaches selectively altering the size and position of a window based on a screen resolution threshold whereby the resolution of the window does not change. Thus, we find that the combined disclosures of Rodden and Buote teach “comparing the screen resolution against a pre-determined threshold value,” and “automatically maximizing the size of the window on the display screen

if the screen resolution is below the pre-determined threshold value, wherein the screen resolution does not change,” as recited in independent claim 1.⁴

Analogous Art

We find that both Rodden and Buote reasonably pertain to the problem with which Appellants were concerned at the time of the claimed invention. In particular, Appellants sought to automatically render a window on a computer display screen in a maximized state when a certain resolution threshold is met. (Spec. 1, ll. 7-9; Spec. 4, ll. 19-21.) Similarly, Rodden is concerned with automatically repositioning or resizing windows within a GUI display in response to changes in display configuration. (FF 2.) In particular, Rodden discloses varying the resolution of the GUI display according to user preferences. (FF 2, 4.) Additionally, Buote pertains to maximizing a window within a GUI display based on a comparison to a predetermined screen resolution threshold. (FF 6.) Thus, we agree with the Examiner that an ordinarily skilled artisan would have recognized that Rodden and Buote are directed to the problem of responding to resolution change in a GUI display (Ans. 14), which is the same problem Appellants were concerned with at the time of the claimed invention.

Teaching Away

We are not persuaded by Appellants’ argument that the combination of Rodden and Buote is impermissible because Rodden’s disclosure of calculating a preferred size and position for a window teaches away from Buote’s disclosure of displaying all window screens at 600x800 resolution.

⁴ In deciding this appeal, we have considered only those arguments that Appellants submitted in the Appeal Brief. Arguments that Appellants could have made but chose not to make in the Appeal Brief are deemed to have been waived. *See In re Watts*, 354 F.3d 1362, 1368 (Fed. Cir. 2004).

(App. Br. 12-13.) As set forth above, we find that Rodden's disclosure teaches that a user may determine the size and screen position of a window within a GUI display and render the window accordingly. (FF 2-3.) Appellants have shown nothing in Buote that would have discouraged an ordinarily skilled artisan from preventing a user of Rodden's system from rendering a window within a GUI display according to a specified size and screen position. Appellants have not pointed to an explicit disclosure within Buote stating that potential users are prevented from rendering a window within a GUI display according to a specified size and screen position. Instead, Buote's disclosure of maximizing a window based on a comparison to a predetermined screen resolution threshold is an alternative or equivalent teaching to rendering a window within a GUI display according to a specified size and screen position. Therefore, Appellants have not shown that Buote's disclosure of maximizing a window based on a comparison to a predetermined screen resolution threshold teaches away from Rodden's disclosure of allowing a user to determine the size and screen position of a window within a GUI display and rendering the window accordingly. It follows that Appellants have not shown that the Examiner erred in concluding that Rodden and Buote render independent claim 1 unpatentable.

Claim 3

Appellants contend that Rodden's disclosure of specifying the size and position of a window does not teach that the window is incapable of being maximized or lacks a specified size and position. (App. Br. 19-20.) Further, Appellants argue that Appellants' Specification is not admitted prior art and cannot be used to teach that the disputed limitation is old and well known. (Reply Br. 15.) Thus, Appellants argue that the proffered

combination does not teach: 1) “if a size and position are not specified, determining if the window is capable of being maximized on the display screen;” and 2) “if the window is incapable of being maximized, rendering the window in a non-maximized size on the display screen, so that the window is not automatically maximized,” as recited in dependent claim 3. (App. Br. 19-20; Reply Br. 15.) We do not agree.

As detailed in the Findings of Fact section above, Appellants’ Specification discloses that some windows are only created in one size and incapable of maximization. (FF 1.) We find that Appellants’ Specification discloses that some windows are only one size and, therefore, incapable of being rendered in a maximized state within a GUI display. However, we decline to use Appellants’ Specification as admitted prior art because the portion of Appellants’ Specification cited by the Examiner was not set forth in Appellants’ Background of the Invention section, nor does it explicitly state that is old and well known for all windows to be incapable of being maximized. Nonetheless, we find that an ordinarily skill artisan would readily appreciate that if the size and position of a window is not specified and the window is incapable of being maximized on a GUI display, it cannot be rendered in a maximized state. It follows that Appellants have not shown that the Examiner erred in concluding that Rodden and Buote render dependent claim 3 unpatentable.

Claims 4 and 11

Appellants contend that neither Rodden nor Buote inherently teaches a restore button and, further, the Examiner’s assertion of Official Notice that utilizing a restore button is old and well known in the art is not based on either fact or technical reason. (App. Br. 20-21.) Additionally, Appellants

argue that the Examiner's reliance on Hatori's disclosure to teach the disputed limitation is improper because it constitutes a new ground of rejection. (Reply Br. 17-18.) Thus, Appellants' allege that the proffered combination does not teach: 1) "determining if the restore button has been initiated;" and 2) "if the restore button has been initiated, reducing the size of the window on the display screen by a pre-determined amount," as recited in dependent claim 4. We do not agree.

MPEP § 2144.03(C) provides the requirements to traverse Official Notice: "[S]pecifically point out the supposed errors in the [E]xaminer's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art." See 37 C.F.R. 1.111(b) (2005). See also *In re Chevenard*, 139 F.2d 711, 713 (CCPA 1943). We find that Appellants have failed to adequately traverse the Examiner's Official Notice. In particular, Appellants have failed to provide evidence to dispel the Examiner's finding that the noticed fact is not considered to be common knowledge or well known in the art. Nonetheless, the Examiner provides documentary evidence in the Examiner's Answer. As detailed in the Findings of Fact section above, Buote discloses buttons in the upper right hand corner of a GUI display. (FF 7.) In particular, Buote discloses that the X button performs the same function as the "back" selection on any GUI display. (*Id.*) We find that Buote's X button teaches a button for restoring a window in a GUI display to a previous state. In particular, we find that an ordinarily skilled artisan would appreciate that Buote's disclosure of utilizing a button to restore a window in a GUI display to a previous state amounts to utilizing a restore button to reduce the size of a window in GUI

display by a predetermined amount. Thus, we find that the cited disclosure of Buote's teaches the disputed limitations.

Additionally, we note that, in response to Appellants' request, the Examiner furnished additional documentary evidence (i.e., the Hatori reference) to support the Examiner's taking of Official Notice (*see* App. Br. 21). In particular, the Examiner cited Hatori's disclosure as evidence that restoring a display window from a zoom display to a previous state is well-known in the art. (FF 8; *see also* Ans. 18.) We find that Hatori's disclosure also teaches utilizing a restore button in a GUI display to reduce the size of window a predetermined amount. We are satisfied that the Examiner has provided sufficient documentary evidence to corroborate the taking of Official Notice. It follows that Appellants have not shown that the Examiner erred in concluding that the combination of Rodden and Buote renders dependent claim 4 unpatentable.

Appellants do not provide separate arguments for patentability with respect to dependent claim 11. Therefore, we select dependent claim 4 as representative of the cited claim. Consequently, Appellants have not shown error in the Examiner's rejection of dependent claim 11 for the reasons set forth in our discussion of dependent claim 4. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2008).

Claims 5 through 9, 12, and 13

Appellants do not provide separate arguments for patentability with respect to independent claim 8 and dependent claims 5 through 7, 9, 12, and 13. Therefore, we select independent claim 1 as representative of the cited claims. Consequently, Appellants have not shown error in the Examiner's rejection of independent claim 8 and dependent claims 5 through 7, 9, 12,

and 13 for the reasons set forth in our discussion of independent claim 1.
See 37 C.F.R. § 41.37(c)(1)(vii) (2008).

Claim 14

Appellants do not provide separate arguments for patentability with respect to independent claim 14. Therefore, we select independent claim 1 and dependent claims 4 and 11 as representative of the cited claim. Consequently, Appellants have not shown error in the Examiner's rejection of independent claim 14 for the reasons set forth in our discussion of independent claim 1 and dependent claims 4 and 11. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2008).

VI. CONCLUSION OF LAW

Appellants have not shown that the Examiner erred in rejecting claims 1, 3 through 9, and 11 through 14 as being unpatentable under 35 U.S.C. § 103(a).

VII. DECISION

We affirm the Examiner's decision to reject claims 1, 3 through 9, and 11 through 14.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2009).

AFFIRMED

nhl

Appeal 2009-004442
Application 10/001,442

SHOOK, HARDY & BACON L.L.P.
(MICROSOFT CORPORATION)
INTELLECTUAL PROPERTY DEPARTMENT
2555 GRAND BOULEVARD
KANSAS CITY, MO 64108-2613